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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Daniel Judge

Art Unit : 2859

Serial No. : 10/068,078

Examiner : Amanda J. Hoolahan

Filed : February 5, 2002

Title : IDENTIFYING MARKER FOR END OF ROLLED PRODUCT

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Hon. Commissioner for Patents

P.O. Box 1450

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SECOND BRIEF FOR APPELLANT

(i) *Real Party in Interest.*

Daniel Judge

(ii) *Related Appeals and Interferences.*

An earlier appeal in this application was filed on September 26, 2003, and the first brief filed December 26, 2003.

(iii) *Status of Claims.*

Claims 1, 2, 4 and 9-14 have been cancelled. Claims 3 and 5-7 being appealed stand rejected under 35 U.S.C. §102(b) as being unpatentable over Thomason, claims 15-18, 20, 21, 23, 24 and 26 being appealed stand rejected under 35 U.S.C. §103(a) as unpatentable over Johnson as a primary reference in view of Thomason as a secondary reference, claim 25 being appealed stands rejected under 35 U.S.C. §103(a) as unpatentable over Johnson as a primary reference, Thomason as a secondary reference and Clayton as a tertiary reference, claim 27 being appealed stands rejected under 35 U.S.C. §103(a) as unpatentable over Johnson as a primary

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reference, Thomason as a secondary reference and Hollanberg as a tertiary reference and claim 28 being appealed stands rejected under 35 U.S.C. §103(a) as unpatentable over Johnson as a primary reference, Thomason as a secondary reference and Kildune as a tertiary reference. Claims 8, 19 and 22 were objected to as being dependant upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(iv) *Status of Amendments.*

No amendment was filed subsequent to final rejection.

(v) *Summary of Claimed Subject Matter..*

The invention comprises a rolled product of contiguous separable sheets. At least first and second contiguous separable sheets of product are wound around an axis forming a cylindrical roll, such as 10, with each sheet having an outer edge positioned parallel to the axis. At least the first and second contiguous separable sheet of product has at least one indicium that bears a predetermined relationship when the first sheet is the outermost sheet of the rolled product such that a discontinuity of the indicium is likely to be formed between the outer edge of each sheet having the indicium and the portion of the indicium which lies directly beneath the outer edge of the sheet having the indicium when the sheets are formed into a cylindrical roll, wherein the indicium is a continuous undulating indicium, such as scroll 51 or 52. There may be a plurality of indicium, such as 51 and 52. The plurality of indicium may be out-of-phase from each other, such as 51 and 52. Each of the continuous undulating indicium may be sinusoid-shaped having a predetermined wavelength that may be substantially equal to L, such as 51 and 52. L may correspond to the length of a sheet.

A method for making a roll of contiguous separable sheets of product with a mark for visually locating the end of the roll according to the invention includes marking the sheets with at least one visually perceivable mark extending the length of each of the sheets continuously for the entire length of the roll, such as 51 or 52. The visually perceivable mark bears a predetermined relationship between the portion of the mark at the edge of each sheet and the portion of the mark that lies directly beneath each edge when the sheets are spooled onto a roll,

such that a discontinuity is likely formed between the mark and any sheet edge and the portion of the mark which lies directly beneath the edge on the roll, thereby allowing the end of the rolled product to be visually located. Then spool the sheets into a cylindrical roll. The method may include marking the sheets with a plurality of marks, such as 51 and 52, that may be sinusoid-shaped and out-of-phase from one another. Each of the sheets may have a length equal to L with each of the sinusoid-shaped marks having a wavelength substantially equal to L.

Page 3, lines 6-30.

(vi) Grounds of Rejection to be Reviewed on Appeal.

1. The rejection of claims 3 and 5-7 under 35 U.S.C. §102(b) as unpatentable over Thomason.
2. The rejection of claims 15-18, 20, 21, 23, 24 and 26 under 35 U.S.C. §103(a) as unpatentable over Johnson as a primary reference in view of Thomason as a secondary reference.
3. The rejection of claim 25 under 35 U.S.C. §103(a) as unpatentable over Johnson as a primary, Thomason as a secondary reference and Clayton as a tertiary reference.
4. The rejection of claim 27 under 35 U.S.C. §103(a) as unpatentable over Johnson as a primary reference, Thomason as a secondary reference and Hollenberg as a tertiary reference.
5. The rejection of claim 28 under 35 U.S.C. §103(a) as unpatentable over Johnson as a primary reference, Thomason as a secondary reference and Kildune as a tertiary reference.

(vii) Argument.

I. THOMASON DOES NOT ANTICIPATE CLAIMS 3 AND 5-7 UNDER §102(A) BECAUSE THE REFERENCE FAILS TO DISCLOSE EACH AND EVERY ELEMENT SET FORTH IN THESE CLAIMS ARRANGED AS IN THESE CLAIMS, SUCH AS THE CONTINUOUS UNDULATING INDICUM OVER THE LENGTH OF THE ROLL.

The second final action states:

Claims 3 and 5-7 are finally rejected under 35 U.S.C. §102(b) as being unpatentable by USPN 4,195,787 to Thomason.

Numerals A and B have been added to Figure 2 and numeral C has been added to Figure 6 in reference to certain components of the rolled product disclosed by Thomason.

Thomason discloses a rolled product of continuous separable sheets, comprising at least a first (A) and second (B) contiguous separable sheet of product wound around an axis (C), forming a cylindrical roll, each sheet having an outer edge positioned parallel to the axis, at least the first and second contiguous separable sheet (A,B) of product (11) having at least one indicium (14) that bears a predetermined relationship when the first sheet is the outer most sheet of the rolled product (11), such that a discontinuity of the indicium is likely to be formed between the outer edge of each sheet having the indicium and the portion of the indicium which lies directly beneath the outer edge of each sheet having the indicium when the sheets are formed into a cylindrical roll, wherein the indicium is a continuous undulating indicium (14', see Figure 4) (column 1, lines 22-23); at least the first and second sheet of contiguous separable sheets (A, B) of product (11) have a plurality of indicium (14, D); the plurality of indicium are out-of-pase from each other, the continuous undulating indicium are sinusoid-shaped (See Figure 4) having a predetermined wavelength.

"It is well settled that anticipation under 35 U.S.C. 102 requires the presence in a single reference of all of the elements of a claimed invention." *Ex parte Chopra*, 229 U.S.P.Q. 230, 231 (BPA&I 1985) and cases cited.

"Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

"This court has repeatedly stated that the defense of lack of novelty (i.e., 'anticipation') can only be established by a single prior art reference which discloses each and every element of the claimed invention." *Structural Rubber Prod. Co. v. Park Rubber Co.*, 223 U.S.P.Q. 1264, 1270 (Fed. Cir. 1984), citing five prior Federal Circuit decisions since 1983 including *Connell*.

In a later analogous case the Court of Appeals for the Federal Circuit again applied this rule in reversing a denial of a motion for judgment n.o.v. after a jury finding that claims were anticipated. *Jamesbury Corp. v. Litton Industrial Prod., Inc.*, 225 U.S.P.Q. 253 (Fed. Cir. 1985).

After quoting from *Connell*, "Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim," 225 U.S.P.Q. at 256, the court observed that the patentee accomplished a constant tight contact in a ball valve by a lip on the seal or ring which interferes with the placement of the ball. The lip protruded into the area where the ball will be placed and was thus deflected after the ball was assembled into the

valve. Because of this constant pressure, the patented valve was described as providing a particularly good seal when regulating a low pressure stream. The court quoted with approval from a 1967 Court of Claims decision adopting the opinion of then Commissioner and later Judge Donald E. Lane:

[T]he term "engaging the ball" recited in claims 7 and 8 means that the lip contacts the ball with sufficient force to provide a fluid tight seal. *** The Saunders flange or lip only sealingly engages the ball 1 on the upstream side when the fluid pressure forces the lip against the ball and never sealingly engages the ball on the downstream side because there is no fluid pressure there to force the lip against the ball. The Saunders sealing ring provides a compression type of seal which depends upon the ball pressing into the material of the ring. *** The seal of Saunders depends primarily on the contact between the ball and the body of the sealing ring, and the flange or lip sealingly contacts the ball on the upstream side when the fluid pressure increases. 225 U.S.P.Q. at 258.

Relying on *Jamesbury*, the ITC said, "Anticipation requires looking at a reference, and comparing the disclosure of the reference with the claims of the patent in suit. A claimed device is anticipated if a single prior art reference discloses all the elements of the claimed invention as arranged in the claim." *In re Certain Floppy Disk Drives and Components Thereof*, 227 U.S.P.Q. 982, 985 (U.S. ITC 1985).

These claims include the limitation that the indicium be continuous, such as 52 and 51, and as described on page 3 of the specification beginning at line 6. The reference fails to disclose this limitation, instead disclosing the discontinuity between the indicium spanning the four sheets shown in FIG. 4 of the reference and those on the fragmentarily illustrated sheets at each end.

"A reference is only good for what it clearly and definitely discloses." *In re Hughes*, 145 U.S.P.Q. 467, 471 (C.C.P.A. 1965); *In re Moreton*, 129 U.S.P.Q. 227, 230 (C.C.P.A. 1961).

Manifestly, the reference fails to disclose this limitation.

If this ground of rejection were repeated, the Examiner was respectfully requested to quote verbatim the language in the reference regarded as corresponding to the continuous undulating indicium or the visually perceivable mark extending continuously along the length of each of the sheets continuously for the length of the entire roll. The Examiner's response was set forth in the last four lines quoted above.

Column 1, lines 22-23 in the reference states, "Typically, any form of marking is repeated continuously along the length of the rolled product." (Emphasis added.) Thus, the reference, discloses not a continuous undulating indicium extending continuously along the length of each of the sheet continuously for the length of the entire roll as disclosed and claimed in this application, but a form of marking that is repeated continuously along the length of the rolled product each form of marking extending only along the length of a group of sheets in the roll and being repeated while having a discontinuity between contiguous repetitions as clearly shown in FIG. 4 with the wiggly marking, FIG. 3 with the straight line marking extending over four sheets, FIG. 2 with the straight line marking extending over four sheets and concluding along an intermediate four sheets of a group of six while terminating on a first and sixth and FIG. 1 showing a straight line extending over a group of four.

This reference, failing to disclose the continuous undulating indicium over the length of the roll, cannot disclose the plurality of continuous indicium that extend over the length of the roll, or the plurality of such contiguous indicium that are out-of-phase from each other.

What the Examiner is doing is using the claims being rejected as a blueprint or template for attempting to read the claims being rejected upon the prior art. That approach is not a proper basis for rejecting claims.

The alleged teaching is found, not in the references but in the claims being rejected. It is error to reconstruct the claimed invention from the prior art by using the rejected claim as a "blueprint." *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 548 (Fed. Cir. 1985).

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.¹⁵ This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."¹⁶ *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1784 (Fed. Cir. 1992).

¹⁵ *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). See also *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

¹⁶ *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600.

II. CLAIMS 15-18, 20, 21, 23, 24 AND 26 MEET THE CONDITIONS FOR PATENTABILITY AT LEAST BECAUSE THE REFERENCES DO NOT SUGGEST THE DESIRABILITY OF COMBINING WHAT IS THERE DISCLOSED TO MEET THE TERMS OF THE REJECTED CLAIMS, AND IT IS IMPOSSIBLE TO COMBINE THE REFERENCES TO MEET THE TERMS OF THE REJECTED CLAIMS.

The second final office action states:

Claims 15-18, 20-21,23-24 and 26 are finally rejected under 35 U. S. C. 103(a)as being unpatentable over USPN 6,282,807 to Johnson in view of Thomason.

Johnson discloses a rolled product wherein normal manufacture of the product comprises the method steps of making a roll of product with a mark for visually locating the end of the roll comprising marking the sheets with at least one visually perceivable mark extending the length continuously for the entire length of said roll, the visually perceivable mark bearing a predetermined relationship between the portion of the mark at the edge of the roll and the portion of the mark that lies directly beneath each edge when the product is spooled onto a roll, such that a discontinuity is likely formed between the mark at any edge and the portion of the mark which lies directly beneath the edge on the roll, thereby allowing the end of the rolled product to be visually located and spooling the product into a cylindrical roll; the indicium is printed on the sheets (column 6, lines 21-23).

Johnson does not disclose the rolled product to be a roll of contiguous separable sheets of product; marking the sheets with a plurality of marks; the plurality of marks being sinusoidshaped, the sinusoid-shaped marks are out of phase from one another; the sheets being toilet paper; the sheets being paper toweling.

With respect to claims 15, 20-21,23-24, and 26: Thomason discloses the rolled product, such as toilet paper (column 1, paragraph 1)and/or paper toweling (column 1, paragraph 1)as described above in paragraph 2 wherein normal manufacture of the device comprises the method steps of making a roll of contiguous separable sheets of product with a mark for visually locating the end of the roll comprising marking the sheets with at least one visually perceivable mark extending the length of each of the sheets, the visually perceivable mark bearing a predetermined relationship between the portion of the mark at the edge of each sheet and the portion of the mark that lies directly beneath each edge when the sheets are spooled onto a roll, such that a discontinuity is likely formed between the mark at any sheet edge and the portion of the mark which lies directly beneath the edge on the roll, thereby allowing the end of the rolled product to be visually located and spooling the sheets into a cylindrical roll. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add perforations to the rolled product, disclosed by Johnson, to replace the serrated edge so the rolled product will be

made of separable sheets, as taught by Thomason, in order for the rolled product to be more convenient for the user because they more easily tear off only as much product as needed without the risk of cutting themselves on the serrated edge or blade.

With respect to claims 16-18: Thomason discloses the rolled product as described above in paragraph 2 wherein normal manufacture of the device comprises the method steps of marking the sheets with a plurality of marks and the plurality of marks are each sinusoid-shaped and out of phase with one another (see Figure 4). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use sinusoid-shaped marks which are out of phase with one another, as taught by Thomason, instead of the mark, disclosed by Johnson, in order for the product to be more visually appealing while ensuring that a user will be able to see the indicating mark. Pp. 3-5

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

"Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'" *In re Laskowski*, 10 U.S.P.Q. 2d 1397, 1398 (Fed. Cir. 1989).

"The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original, footnotes omitted).

"The critical inquiry is whether 'there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. [citing Lindemann with emphasis added.]" *Fromson v. Advance Offset Plate, Inc.*, 225 U.S.P.Q. 26, 31 (Fed. Cir. 1985).

As the Federal Circuit Court of Appeals said in *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999):

Close adherence to this methodology is especially important of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'

And in *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000), the Court said:

[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* [*Dembiczak*]. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998), *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See *B. F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996).

We have shown above that the secondary reference fails to disclose the limitation in all these claims calling for the visually perceivable mark extending the length of each of the sheets continuously for the entire length of the roll, and the primary reference fails to overcome this shortcoming. The primary reference is concerned with indicating the balance of a continuous roll, not the beginning of a roll of sheets. It is thus impossible to combine the primary and secondary references to meet the terms of claims 15-18, 20, 21, 23, 24 and 26.

"Moreover, we observe that even if these references were combined in the manner proposed by the examiner, that which is set forth in appellant's claims . . . would not result." *Ex parte Bogar*, slip op. p.7 (BPA&I Appeal No. 87-2462, October 27, 1989). "Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed." *Ex parte Schwarz*, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992). "Although we find nothing before us indicating why it would be desired to combine the references in the manner urged by the examiner, it is clear to us that such a modification by itself would not result in that which is set forth in the claims." *Ex Parte Kusko*, 215 U.S.P.Q. 972, 974 (BPA&I 1981).

That it is impossible to combine the references to meet the terms of these claims is reason enough for reversing the final rejection of them.

Moreover, nothing in the references suggests the desirability of combining what is there disclosed to meet the terms of the rejected claims. If the Examiner persists in maintaining this ground of rejection, she is respectfully requested to quote verbatim the language in each reference regarded as corresponding to each element in each rejected claim and quote verbatim the language in the references regarding as suggesting the desirability of combining what is there disclosed to meet the terms of the rejected claims.

IV. CLAIM 25 MEETS THE CONDITIONS FOR PATENTABILITY UNDER §103 AT LEAST BECAUSE THE PRIMARY, SECONDARY AND TERTIARY REFERENCES DO NOT SUGGEST THE DESIRABILITY OF COMBINING WHAT IS THERE DISCLOSED TO MEET THE TERMS OF THIS CLAIM, AND IT IS IMPOSSIBLE TO COMBINE THE REFERENCES TO MEET THE TERMS OF THE CLAIMS.

The second final action states:

Claim 25 is finally rejected under 35 U. S. C. 103(a) as being unpatentable over Johnson as applied to claim 20 above, and further in view of USPN 4,076,121 to Clayton et al. [hereinafter Clayton].

Johnson and Thomason disclose the rolled product of contiguous separable sheets as described above in paragraph 5.

Johnson and Thomason do not disclose the rolled product wherein the sheets are plastic bags.

Clayton discloses a rolled product being separable sheets of plastic bags. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the indicia disclosed by Johnson and Thomason with a rolled product comprised of separable sheets of plastic bags, as taught by Clayton, in order to determine the free end of the rolled product and since Johnson and Thomason already suggests that the indicia could be used with products manufactured in a rolled form (Thomason, column 1, lines 1 -10). PP. 5-6

Claim 25 is dependent upon and includes all the limitations of claim 20, and the reasons set forth above in support of the patentability of claim 20 over the primary and secondary references is submitted to support the patentability of claim 25 so that further discussion is submitted to be unnecessary. Nevertheless, it is impossible to combine the primary, secondary and cursory references to meet the terms of claim 25, and that is reason enough for reversing the

final rejection of the claims. Nor do the references suggest the desirability of combining what is disclosed there to meet the terms of claim 25.

If the Examiner persists in maintaining this rejection, she is respectfully requested to quote verbatim the language in each reference regarded as corresponding to each element in claim 25, and quote verbatim the language in the references regarded as suggesting the desirability of combining what is there disclosed to meet the terms of this claim.

V. CLAIM 27 MEETS THE CONDITIONS FOR PATENTABILITY UNDER §103 AT LEAST BECAUSE IT IS IMPOSSIBLE TO COMBINE THE PRIMARY, SECONDARY AND TERTIARY REFERENCES TO MEET THE TERMS OF CLAIM 27, AND NOTHING IN THESE REFERENCES SUGGESTS THE DESIRABILITY OF COMBINING WHAT IS THERE DISCLOSED TO MEET THE TERMS OF CLAIM 27.

The second final office action states:

Claim 27 is finally rejected under 35 U. S. C. 103(a) as being unpatentable over Johnson and Thomason as applied to claim 20 above, and further in view of USPN 6,221,211 to Hollenberg et al. [hereinafter Hollenberg].

Johnson and Thomason discloses a rolled product of contiguous separable sheets as described above in paragraph 5.

Johnson and Thomason do not disclose the rolled product wherein the mark is dyed on the sheets.

Hollenberg discloses a tissue product having a mark that is dyed on the sheets (17). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have the indicia dyed on the sheets, as taught by Hollenberg, instead of imprinted, as taught by Johnson and Thomason, since the way that the indicia is added to the rolled product is considered to be nothing more than the use of one of numerous and well known alternate types of methods for adding marks that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to permanently add the indicia on the rolled product. PP. 6-7.

Claim 27 is dependent upon and includes all the limitations of claim 20, and the reasoning set forth above in support of the patentability of claim 20 is submitted to support the patentability of claim 27 so that further discussion of claim 27 is submitted to be unnecessary. We have shown above that the secondary reference fails to disclose the visually perceivable mark extending continuously along the length of each of the sheets continuously along the entire length of the roll, and the primary reference does not overcome this deficiency. It is therefore

impossible to combine these references to meet the terms of claim 27, and that is reason enough for reversing the final rejection of this claim. Nor is there any suggestion in the references of combining what is there disclosed to meet the terms of claim 27.

If the Examiner persists in maintaining this rejection, she is respectfully requested to quote verbatim the language in each reference corresponding to each limitation in claim 27 and quote verbatim the language in the references regarded as suggesting the desirability of combining what is there disclosed to meet the terms of claim 27.

VI. CLAIM 28 MEETS THE CONDITIONS FOR PATENTABILITY AT LEAST BECAUSE IT IS IMPOSSIBLE TO COMBINE THE PRIMARY, SECONDARY AND TERTIARY REFERENCES TO MEET THE TERMS OF CLAIM 28, AND NOTHING IN THESE REFERENCES SUGGESTS THE DESIRABILITY OF COMBINING WHAT IS THERE DISCLOSED TO MEET THE TERMS OF CLAIM 28.

The second final office action states:

Claim 28 is finally rejected under 35 U. S. C. 103(a) as being unpatentable over Johnson and Thomason as applied to claim 20 above, and further in view of USPN 5,266,257 to Kildune.

Johnson and Thomason discloses a rolled product of contiguous separable sheets as described above in paragraph 5.

Johnson and Thomason do not disclose the rolled product wherein the indicia is embossed on the sheets.

Kildune discloses a rolled product having indicia (12) embossed onto the product. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have the indicia embossed on the sheets, as taught by Kildune, instead of imprinted, as taught by Johnson and Thomason, since the way that the indicia is added to the rolled product is considered to be nothing more than the use of one of numerous and well known alternate types of methods for adding marks that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to permanently add the indicia on the rolled product. P. 7.

Claim 28 is dependent upon and includes all the limitations of claim 20, and the reasoning set forth above in support of the patentability of claim 20 is submitted to support the patentability of claim 28 so that further discussion of claim 28 is submitted to be unnecessary. We have shown above that the secondary reference fails to disclose the visually perceivable mark extending continuously along the length of each of the sheets continuously along the entire length of the row, and the primary reference does not overcome this deficiency. It is therefore

impossible to combine these references to meet the terms of claim 28, and that is reason enough for reversing the final rejection of this claim. Nor is there any suggestion in the references of combining what is there disclosed to meet the terms of claim 28.

If the Examiner persists in maintaining this rejection, she is respectfully requested to quote verbatim the language in each reference corresponding to each limitation in claim 28 and quote verbatim the language in the references regarded as suggesting the desirability of combining what is there disclosed to meet the terms of claim 28.


CONCLUSION

In view of the foregoing authority, remarks and the inability of the prior art alone, or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, the decision of the examiner finally rejecting claims 3, 5-7, 15-18, 20, 21 and 23-28 should be reversed. Should the Board be of the opinion that a claim may be allowed in amended form, the Board is respectfully requested to include an explicit statement that such claim may be allowed in such amended form and direct that appellant shall have the right to amend in conformity with such statement in the absence of new references or grounds of rejection.

The brief fee was previously enclosed in response to the first final action. Please apply any other charges or credits to Deposit Account No. 06-1050, Order No. 13808-002001.

Respectfully submitted,
FISH & RICHARDSON P.C.

Date: AUG 23 2004



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(viii) Appendix of Claims.

3. A rolled product of contiguous separable sheets, comprising:

at least a first and second contiguous separable sheet of product wound around an axis, forming a cylindrical roll, each sheet having an outer edge positioned parallel to the axis; and

at least the first and second contiguous separable sheet of product having at least one indicium that bears a predetermined relationship when the first sheet is the outer most sheet of the rolled product, such that a discontinuity of the indicium is likely to be formed between the outer edge of each sheet having the indicium and the portion of the indicium which lies directly beneath the outer edge of each sheet having the indicium when the sheets are formed into a cylindrical roll,

wherein the indicium is a continuous undulating indicium.

5. A rolled product of contiguous separable sheets, comprising:

at least a first and second contiguous separable sheet of product wound around an axis, forming a cylindrical roll, each sheet having an outer edge positioned parallel to the axis; and

at least the first and second contiguous separable sheet of product having at least one indicium that bears a predetermined relationship when the first sheet is the outer most sheet of the rolled product, such that a discontinuity of the indicium is likely to be formed between the outer edge of each sheet having the indicium and the portion of the indicium which lies directly beneath the outer edge of each sheet having the indicium when the sheets are formed into a cylindrical roll,

wherein at least the first and second sheet of contiguous separate sheets of product have a plurality of indicium,

wherein the plurality of indicium are each a continuous undulating indicium.

6. The rolled product of claim 5 wherein the plurality of indicium are out-of-phase from each other.

7. The rolled product of claim 6 wherein each of the continuous undulating indicium are sinusoid-shaped having a predetermined wavelength.

8. The rolled product of claim 7 wherein the sheets are of length L and the wavelength of each of the sinusoid-shaped indicium are substantially equal to L.

15. A method for making a roll of contiguous separable sheets of product with mark for visually locating the end of the roll, comprising:

marking the sheets with at least one visually perceivable mark extending the length of each of the sheets continuously for the entire length of said roll, the visually perceivable mark bearing a predetermined relationship between the portion of the mark at the edge of each sheet and the portion of the mark that lies directly beneath each edge when the sheets are spooled onto a roll, such that a discontinuity is likely formed between the mark at any sheet edge and the portion of the mark which lies directly beneath the edge on the roll, thereby allowing the end of the rolled product to be visually located; and

spooling the sheets into a cylindrical roll.

16. The method of claim 15, further comprising marking the sheets with a plurality of marks.

17. The method of claim 16, wherein the plurality of marks are each sinusoid-shaped.

18. The method of claim 17, wherein each of the sinusoid-shaped marks are out-of-phase from one another.

19. The method of claim 18, wherein each of the said sheets have a length equal to L and each of the sinusoid-shaped marks have a wavelength substantially equal to L.

20. A roll of contiguous separable sheets of product comprising a visually perceivable mark extending continuously along the length of each of the sheets continuously along the entire length of said roll and forming a pattern such that a discontinuity is likely formed between the mark at any sheet edge and the portion of the mark which lies directly beneath the edge on the roll, thereby allowing the end of the rolled product to be visually located.

21. The roll of claim 20, further comprising a plurality of undulating visually perceivable marks extending continuously along the length of the sheets.

22. The roll of claim 21, wherein the plurality of visually perceivable marks are sinusoid-shaped with a wavelength equal to the length of each sheet.

23. The roll of product of claim 20 wherein the sheets are toilet paper.

24. The roll of product of claim 20 wherein the sheets are paper toweling.

25. The roll of product in claim 20 wherein the sheets are plastic bags.
26. The roll of product in claim 20 wherein the mark is printed on the sheets.
27. The roll of product in claim 20 wherein the mark is dyed on the sheets.
28. The roll of product in claim 20 wherein the mark is embossed on the sheets.



FIGURE 1

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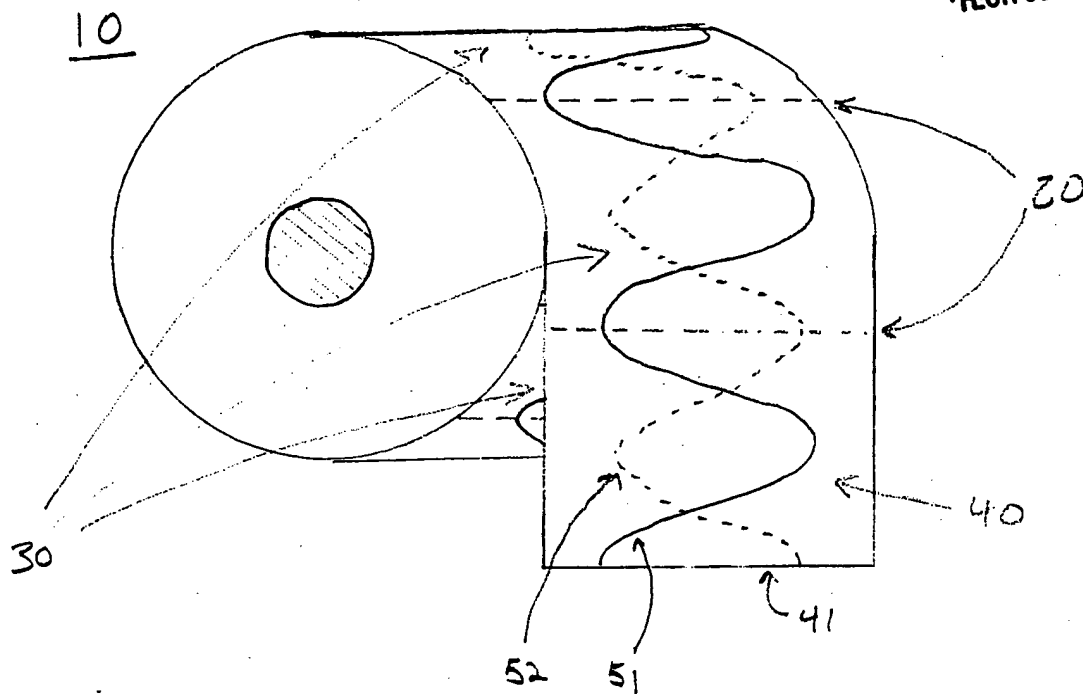
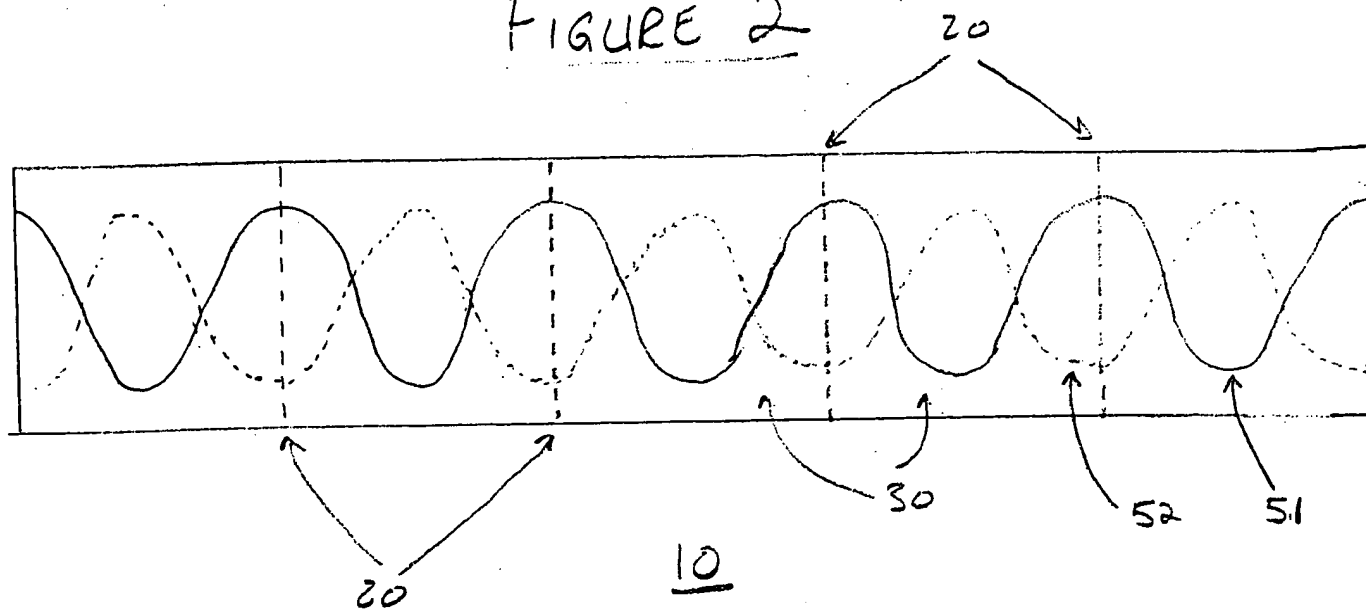


FIGURE 2





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FIGURE 3

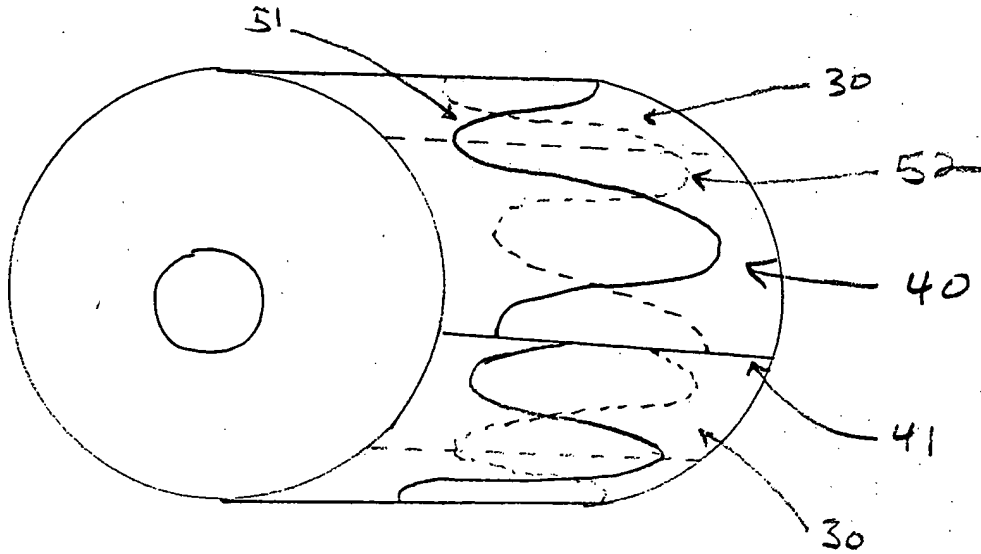


FIGURE 4

